

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants:	Jay S. Walker, James A.)	Group Art Unit: 3714
	Jorasch, Stephen C. Tulley,)	
	David F. Zucker, Andrew D.)	Examiner: PINHEIRO, JASON P.
	Rogers, Geoffrey M. Gelman,)	
	Daniel E. Tedesco)	APPEAL BRIEF
)	
Application No.:	10/787,356)	Attorney Docket No.: 03-005
)	
Filed:	February 26, 2004)	
)	
For:	METHOD AND APPARATUS FOR)	
	PLAY OF A GAME WITH)	
	NEGATIVE OUTCOMES)	
)	
)	
)	
)	

**BOARD OF PATENT APPEALS
AND INTERFERENCES**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants initiate an appeal to the Board of Patent Appeals and Interferences following the Examiner's rejection of Claims 1-24 in the Final Office Action mailed September 28, 2007.

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REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, Two High Ridge Park,
Stamford, CT 06905.

RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative and Appellants' assignee know of no interferences or appeals that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-24 are pending.

Claims 1-24 are rejected and are being appealed.

STATUS OF AMENDMENTS

No claim amendments have been filed subsequent to the Final Office Action mailed September 28, 2007.

Appellants filed a specification amendment on March 11, 2008. In accordance with MPEP 1206, the amendment was filed after the filing of the Notice of Appeal on January 28, 2008, but prior to filing Appellants' Brief to "(B) comply with any requirement of form expressly set forth in a previous action." These requirements of form were noted in Office Actions received in related Applications No. 11/428,726 (the "'726 application" hereinafter) and 11/428,748 (the "'748 application" hereinafter).

The '726 and '748 applications both claims priority to the present application and contains a substantially identical disclosure. In an Office Action mailed on October 26, 2007, in the '726 application, the drawings were objected to because the following reference characters were not mentioned in the description: 370, 380, 390, 810, 900, 910, 920, 930, 940 and 1200. An identical objection was made in the Office Action mailed November 2, 2007, in the '748 Application. Identical specification amendments have been made in the '726 and '748 applications in response to those objections. Therefore, Appellants respectfully submit that the amendments are being made to "comply with [a] requirement of form expressly set forth in a previous action." Appellants also submit that the above circumstances constitutes "good and sufficient reasons why the amendment is necessary and was not earlier presented," in accordance with MPEP 1206 and 37 CFR 41.33(a), and may be entered on this independent ground as well.

As Appellants noted in a telephonic interview of March 11, 2008, with Examiner Pinheiro, the above amendments put the Application in better form for allowance and do not affect the issues presently on appeal.

SUMMARY OF CLAIMED SUBJECT MATTER

Claims 1, 11, 13 and 17 are the only independent claims.

Concise explanations of the independent claims are provided below. As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification. Any such reference and / or accompanying explanation:

(i) is by way of example of the claimed subject matter only and is not a comprehensive description of the scope of the independent claim being discussed, nor a comprehensive listing of support in the specification for the independent claim being discussed;

(ii) might be potentially useful in clarifying the particular subject matter of the particular independent claim being discussed (and not other claims or “the invention” as a whole), unless explicitly stated otherwise; and

(iii) is not to be considered as broadening or narrowing or otherwise affecting the interpretation of any claim or part of a claim, unless explicitly stated otherwise.

Additionally, any explanation or reference to the specification which refers to more than one claim, or is utilized in the explanation of more than one claim, is not to be considered as broadening or narrowing or otherwise affecting the interpretation of any claim or part of a claim, and is not to be considered as indicating any equivalence of any claims or parts of a claim.

1. Independent Claim 1

In accordance with one or more embodiments, independent Claim 1 recites a method.

The method includes initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls. See Specification, page 5:22-24, 13:7-8; FIG 6 and accompanying text.

The method further includes determining at a first time a first situation of the secondary game, in which the first situation includes a first amount of time available for completing the secondary game. See Specification, page 22:15-17.

The method further includes determining, based on a random number generator, a first outcome. See Specification, page 56:5-9.

The method further includes determining, at a second time, based on the first game situation and the first outcome, a second game situation, in which the second game situation includes a second amount of time available for completing the secondary game. See Specification, page 22:15-32.

Finally, the method further includes a limitation that the difference between the first amount of time and the second amount of time is greater than the elapsed time between the first time and the second time. See Specification, page 23:1-4.

2. Independent Claim 11

In accordance with one or more embodiments, independent Claim 11 recites a method.

The method includes initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls. See Specification, page 5:22-24, 13:7-8; FIG 6 and accompanying text.

The method further includes determining a first situation of the secondary game, in which the first situation includes a first number of handle pulls available for completing the secondary game. See Specification, page 23:26-30, 44:29-30, 45:14-15; FIGS. 7 (710), 8 (810), 10 and accompanying text.

The method further includes determining a first outcome; and determining based on the first game situation and the first outcome, a second game situation, in which the second game situation includes a second number of handle pulls available for completing the secondary game.

See Specification, page 23:26-30, 44:29-30, 45:14-15; FIGS. 7 (710), 8 (810), 10 and accompanying text.

3. Independent Claim 13

In accordance with one or more embodiments, independent Claim 13 recites a method.

The method includes initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls. See Specification, page 5:22-24, 13:7-8; FIG 6 and accompanying text.

The method further includes determining a first situation of the secondary game, in which the first situation includes a first plurality of locations that may be occupied by a game character, in which the first situation includes a first set of connections among the first plurality of locations, and in which at least one of the first plurality of locations confers an advantage to a player if occupied by the game character. See Specification, page 3:8-15, 5:25-28, 13:22-28; FIG 12 (1210, 1220) and accompanying text.

The method further includes determining a first outcome; and determining a second situation of the secondary game, in which the second situation includes a second plurality of locations that may be occupied by the game character, in which the second situation includes a second set of connections among the second plurality of locations, and in which at least one of the second plurality of locations confers an advantage to the player if occupied by the game character. See Specification, page 3:8-15, 5:25-28, 13:22-28; FIG 12 (1210, 1220) and accompanying text.

The method further includes limitations wherein there is at least one difference between at least one of the first plurality of locations of the first situation as compared to the second plurality of locations of the second situation and the first set of connections of the first situation as compared to the second set of connections of the second situation. See Specification, page 22:24-23:5.

4. Independent Claim 17

In accordance with one or more embodiments, independent Claim 17 recites a method.

The method includes initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls. See Specification, page 5:22-24, 13:7-8; FIG 6 and accompanying text.

The method further includes determining a first situation of the secondary game, in which the first situation includes an objective within the secondary game and a first prize amount associated with the objective. See Specification, page 31:5-6; FIG 12(1210, 1220) and accompanying text.

The method further includes determining a first outcome; and determining, based on the first situation and the first outcome, a second situation, in which the second situation includes the objective and a second prize amount associated with the objective. See Specification, page 31:6-32:13.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Section 102

- 1A. Claims 13 and 17 – 19: Rejected under 102(b) as allegedly being anticipated by U.S. Patent Publication No. 2002/0016200 to Baerlocher et al. (“Baerlocher ‘200” hereinafter)
- 1B. Claims 11 and 12: Rejected under 102(e) as allegedly being anticipated by U.S. Patent 6,733,389 to Webb et al. (“Webb” hereinafter)
- 1C. Claims 13 – 19: Rejected under 102(e) as allegedly being anticipated by U.S. Patent 6,602,136 to Baerlocher et al. (“Baerlocher ‘136” hereinafter)

2. Section 103(a)

- 2A. Claims 1 – 4, 8, 10 and 21: Rejected as allegedly being obvious in light of U.S. Patent No. 5,997,400 to Seelig et al. (“Seelig” hereinafter) in view of British Patent No. GB 2,372,218 to Muzaffar et al. (“Muzaffar” hereinafter)
- 2B. Claims 5 – 7: Rejected as allegedly being obvious in light of Seelig in view of Muzffar and further in view of U.S. Patent Publication No 2001/0031654 to Walker et al. (“Walker” hereinafter)
- 2C. Claim 9: Rejected as allegedly being obvious in light of Seelig in view of Muzaffar and further in view of U.S. Patent No. 6,368,216 to Hedrick et al. (“Hedrick” hereinafter)
- 2D. Claim 20: Rejected as allegedly being obvious in light of Baerlocher ‘200 in view of Hedrick
- 2E. Claim 22: Rejected as allegedly being obvious in light of Webb in view of Seelig
- 2F. Claims 23 and 24: Rejected as allegedly being obvious in light of Baerlocher ‘200 in view of Seelig

SUMMARY OF ARGUMENTS

1. Claim Rejections – Section 102

The Claim rejections under 102 all fail to disclose, teach or suggest the limitation “initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls,” recited in independent claims 11, 13 and 17 and all claims dependent therefrom.

Despite a clear and unambiguous definition of the term “handle pull” in Appellants’ specification, described in detail below, the Final Office Action argues that to use Appellants’ explicit definition of the term would improperly import limitations from the specification. This is contrary to the established rule that an applicant may be his own lexicographer, as well as the rule that claims must be given their broadest reasonable interpretation consistent with the specification. MPEP 2173.05(a); 2111. Because none of the cited references contain the limitation as explicitly defined by Appellants’ specification, the rejection should be withdrawn and the claims allowed.

In addition, with respect to claim 13, Baerlocher ‘200 also fails to disclose, teach or suggest the limitation “wherein there is at least one difference between at least one of the first plurality of locations of the first situation as compared to the second plurality of locations of the second situation and the first set of connections of the first situation as compared to the second set of connections of the second situation,” recited in claim 13 and all claims dependent therefrom.

With respect to claim 17, Baerlocher ‘200 also fails to disclose, teach or suggest the limitation of “an objective within the secondary game that is first associated with a first prize amount and then, based on an outcome, a second prize amount,” recited in claim 17 and all claims dependent therefrom.

With respect to claim 11, Webb also fails to disclose, teach or suggest the limitation wherein “the second number of handle pulls is (i) less than one less than the first number of handle pulls and (ii) greater than one,” recited in claim 11 and all claims dependent therefrom.

For at least these reasons, the rejections of claims 11-19 under section 102 should be withdrawn and the claims allowed.

2. Claim Rejections – Section 103(a)

The rejection of claims 1-4, 8, 10 and 21 in light of Seelig and Muzaffar fails to disclose teach or suggest the following limitations of claim 1: “determining, based on a random number, a first outcome,” and “determining, at a second time, based on the first game situation and the first outcome, a second game situation, in which the second game situation includes a second amount of time available for completing the secondary game; in which the difference between the first amount of time and the second amount of time is greater than the elapsed time between the first time and the second time.” With respect to claims 5-7 and 9, Walker and Hedrick similarly fail to disclose these limitations.

With respect to claims 20, Hedrick fails to cure the deficiencies of Baerlocher ‘200, discussed above with respect to claim 17, from which claim 20 depends.

With respect to claim 22,

FORM OF THE APPEAL BRIEF

In the arguments herein, limitations of the claims are indicated in *italics* and the references of record are indicated by underlining.

In separate arguments of patentability for separate claims (or groups of claims), Appellants have, where possible, referred to prior arguments to avoid undue repetition.

ARGUMENT

1. Claim Rejections – Section 102

1A. Claims 13 and 17 – 19 in light of Baerlocher ‘200

Claims **13 and 17 – 19** stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Application Publication No. 2002/0016200 to Baerlocher et al., which published as U.S. Patent No. 6,988,947 (“Baerlocher ‘200” herein). Appellants respectfully traverse this rejection for the reasons set forth below.

First, with respect to both independent claim **13** and independent claim **17**, Appellants respectfully traverse this rejection on the grounds that Baerlocher ‘200 does not describe or suggest modifying a situation of a secondary game based on an outcome of a primary game, as is claimed in independent claims **13 and 17** prior to the amendments made herein. In particular, Appellants respectfully submit that Baerlocher ‘200 fails to teach or suggest the following claim limitation present in each of independent claims **13 and 17**:

initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls

Appellants respectfully note that the specification of the present application, as filed, defines “handle pull” as defined on pg. 3, line 31 – pg. 4, line 2: “*As used herein, the term ‘handle pull’ refers to a complete primary game at a gaming device, involving the placement of a wager, the determination of an at least partially random or pseudo-random outcome, the determination of a payment amount, and the providing or crediting of a player with the payment amount*” (emphasis added). As explained on page 5, lines 16 – 31 of the specification as filed, a primary game is distinct from a secondary game.

The Final Office Action argues at page 21 that “the features on which applicant relies (i.e., handle pull being a complete primary game at a gaming device) are not recited in the rejected claims(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. However, MPEP 2173.05(a) explicitly provides that, “[i]n applying the prior art, the claims should be construed to encompass all

definitions that are consistent with applicant's use of the term. See *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002).” Far from reading limitations from the specification into the claims, as argued by the Final Office Action, the MPEP supports Appellants’ position that the explicit definition of the term “handle pull” in the specification is contained in the claim itself by virtue of Appellants’ use of the term in the claim. No importation of additional limitations from the specification is needed; the Application makes clear that all uses of the term “handle pull” have a clear and apparent meaning.

To the extent that Appellants’ definition is in any way inconsistent with the ordinary meaning of the term “handle pull,” Appellants note also that,

[c]onsistent with the well-established axiom in patent law that a patentee or applicant is free to be his or her own lexicographer, a patentee or applicant may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings if the written description clearly redefines the terms. See, e.g., *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) (“While we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning,” in such a situation the written description must clearly redefine a claim term “so as to put a reasonable competitor or one reasonably skilled in the art on notice that the patentee intended to so redefine that claim term.”); *Hormone Research Foundation Inc. v. Genentech Inc.*, 904 F.2d 1558, 15 USPQ2d 1039 (Fed. Cir. 1990).

MPEP 2173.05(a).

The Final Office Action’s reliance on *In re Van Geuns* (988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)) is inapposite. In that case, the Federal Circuit correctly held that claims to a superconducting magnet which generates a “uniform magnetic field” were not limited to the degree of magnetic field uniformity required for Nuclear Magnetic Resonance (NMR) imaging, even though the specification disclosed that the claimed magnet may be used in an NMR apparatus. Here, Appellants have not used a definition containing “may” or similar open-ended language. Appellants have instead unequivocally stated that “[a]s used herein, the term ‘handle pull’ refers to” the definition above.

In addition, claims must be “given their broadest reasonable interpretation consistent with the specification.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). Under 37 C.F.R. 1.75(d)(1), “[t]he terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be

ascertainable by reference to the description." In the absence of a clear and explicit definition of the term "handle pull," the Final Office Action's position might be considered the broadest reasonable interpretation, but when the term is read in light of the specification's clear and unambiguous definition, the meaning and scope of the term "handle pull" is clear and unmistakable.

Accordingly, the proper claim construction of claim 13 will include an acknowledgement that "[a]s used herein, the term 'handle pull' refers to a complete *primary game* at a gaming device, involving the placement of a wager, the determination of an at least partially random or pseudo-random outcome, the determination of a payment amount, and the providing or crediting of a player with the payment amount," as explicitly defined by Appellants.

Baerlocher '200 describes movement of a player symbol and termination symbol in a bonus round. While the bonus round may be triggered by an outcome of a primary game, once the bonus round is initiated and entered into by a player, the player plays the bonus round until it terminates and the primary game is paused during the duration of the bonus round. See, for example, (i) paragraph [0043]: "...automatically begin bonus round when the player has achieved a qualifying condition in the game..."; (ii) paragraph [0044]: "If a player achieves a bonus triggering or qualifying condition while playing the game, the gaming device 10 automatically displays a screen for the bonus round..."; (iii) paragraph [0071]: "there are preferably three manners in which the bonus round can terminate...the bonus round terminates...the game awards bonus credits gained by the player." Baerlocher '200 describes that the graphical output of the bonus round may be output via the same video monitor 32 that displays the reels of the primary game. (e.g., paragraphs [0037] and [0043], evidencing that the play of the reels of the primary game does not occur during the bonus round once it is entered. Figure 10 of Baerlocher '200 illustrates that a player has the option of either spinning the reels or playing the bonus round, thus further evidencing that the bonus round is a distinct process that occurs outside of the context of the primary game once it is triggered and entered into by a player. As described in Baerlocher '200, a player using a play activator of the gaming device during the primary game may cause reels to resolve on a combination of symbols that correspond to a payout that is provided to a player (e.g., paragraph [0042]. However, a player's usage of a play activator of the gaming device during the bonus round only causes movement of the player symbol (e.g., paragraph [0067]); there is no description that the resolution of the reels during a

bonus round may directly correspond to any payout being provided to the player, thus further evidencing that Baerlocher '200 does not contemplate an outcome of a primary game ever affecting the movement of a player symbol or termination symbol in the bonus round or in any manner affects any progress, results or changes in the bonus round. The Final Office Action does not appear to dispute this conclusion, instead only arguing that the scope of the term “handle pull” is broader than the specification’s explicit definition warrants.

In fact, Baerlocher '200 describes that distinct reels and reel symbols are output in a bonus screen during a bonus round from those displayed during the primary game (e.g., element 86 of Figure 11; paragraph [0066]), to reflect the two characters of the bonus round. There is no enablement in Baerlocher '200 for the reels or reel symbols of the primary game to be involved in affecting the movement of the player symbol and the terminating symbol in the bonus round. The primary game of Baerlocher '200 does not in any manner affect the bonus round once the bonus rounds is triggered.

Additionally, with respect to independent claim **13**, Appellants respectfully traverse this rejection on the grounds that Baerlocher '200 does not teach or suggest the following limitation:

wherein there is at least one difference between at least one of

the first plurality of locations of the first situation as compared to the second plurality of locations of the second situation and

the first set of connections of the first situation as compared to the second set of connections of the second situation

In other words, the layout of the game (whether it is the layout of possible locations and/or possible connections among such locations) changes as between the first situation and the second situation. Such an embodiment is supported by the specification as filed at least on page 26, line 15 through page 28, line 5. In Baerlocher '200, although a player symbol and/or a termination symbol may move along a path, there is no description of an outcome causing a change in the path such that there is a change of the locations and/or connections among locations in the path.

Additionally, with respect to independent claim **17**, Appellants respectfully traverse this rejection on the grounds that Baerlocher '200 does not teach or suggest the following limitation:

an objective within the secondary game that is first associated with a first prize amount and then, based on an outcome, a second prize amount

In other words, an objective such as reaching a particular location of a game layout may be associated with a prize and the prize associated with the location may be changed as a result of an outcome. Such an embodiment is described at least on page 31, lines 5 – 30 of the specification as filed. In Baerlocher ‘200, although a player may continue to add potential credits to be won as a result of the termination of the bonus round, the only objective associated with such credits is termination of the bonus round (the event that causes any accumulated credits to be paid out to the player). The termination of the bonus round is not an objective *within* the bonus round. Appellants respectfully submit that there is absolutely no description in Baerlocher ‘200 of an outcome affecting a prize associated with an objective *within* the game, an objective which is other than the termination of the game.

Dependent claims **18 and 19** are patentable at least for the same reason as independent claim **17** from which they depend, which is discussed above.

1B. Claims 11 and 12 in light of Webb

Claims **11 and 12** stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,733,389 to Webb et al. (“Webb” herein). Appellants respectfully traverse this rejection on the grounds that Webb does not teach or suggest a secondary game being affected by an outcome of a primary game. In particular, Webb does not teach or suggest the following limitation of claim **11** (and of claim **12**, by virtue of its dependency on claim **11**):

initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls

As explained with reference to claim **13 and 17**, above, a “handle pull” as defined in the specification of the present application is a complete primary game of at a gaming device. Webb, like Baerlocher ‘200, is limited to describing progress in a secondary game that is a bonus game entered into upon a qualifying condition being achieved in the primary game. However,

once the bonus round is entered, no outcome of the primary game affects the progress or changing of situation in the bonus round.

With respect to claim **12**, Webb also fails to disclose teach or suggest the following limitation:

the second number of handle pulls is (i) less than one less than the first number of handle pulls and (ii) greater than one

Webb does not describe or suggest deducting a number of handle pulls as a result of a handle pull by more than one yet such that the number of available handle pulls remains greater than zero. Rather, a third strike symbol in Webb results in a termination of the secondary game and thus a resetting of the number of spins remaining to zero.

1C. Claims 13 – 19 in light of Baerlocher ‘136

Claims **13 – 19** stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,602,136 to Baerlocher et al. (“Baerlocher ‘136” herein). Appellants respectfully traverse this rejection on the grounds set forth below.

Appellants respectfully traverse this rejection on the grounds that Baerlocher ‘136, like Baerlocher ‘200 and Webb, does not teach or suggest a secondary game being affected by an outcome of a primary game. In particular, Baerlocher ‘136 does not teach or suggest the following limitation of claim **13** (and of claims **14 - 16**, by virtue of their respective dependency on claim **13**) and of claim **17** (and of claims **18 and 19**, by virtue of their respective dependency on claim **17**):

initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls

As explained in section C.1, above, a “handle pull” as defined in the specification of the present application is a complete primary game of at a gaming device. Baerlocher ‘136, like Webb and Baerlocher ‘200, is limited to describing progress in a secondary game that is a bonus game entered into upon a qualifying condition being achieved in the primary game. However,

once the bonus round is entered, no outcome of the primary game affects the progress or changing of situation in the bonus round.

2. Claim Rejections – Section 103(a)

Applicable Law

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the appellant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D 1443, 1444 (Fed. Cir. 1992).

Claim interpretation must be consistent with the specification

During examination, claims are given their broadest reasonable interpretation that those skilled in the art would reach, consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D 1664, 1667 (Fed. Cir. 2000); In re Cortright, 165 F.3d 1353, 1359, 49 U.S.P.Q.2D 1464, 1468 (Fed. Cir. 1999). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” In re Morris, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2D 1023, 1027 (Fed. Cir. 1997).

Substantial evidence required for all factual findings

The Board is not permitted to accept conclusory, unsupported findings made by the Primary Examiner that are not supported by substantial evidence made of record.

All findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. Brand v. Miller, Slip Op. at 8-9 (Fed. Cir. 2007); In re Gartside, 203 F.3d 1305, 1315, 53 U.S.P.Q.2D 1769, 1775 (Fed. Cir. 2000).

The Supreme Court has described “substantial evidence” in the following manner:
substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. .

. . Mere uncorroborated hearsay or rumor does not constitute substantial evidence.

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); see also, Dickinson v. Zurko, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 1935, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) (“Zurko III”).

“[R]eview under this standard involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the agency’s decision.”

Universal Camera Corp. v. NLRB, 340 U.S. 474, 487-88, 95 L. Ed. 456, 71 S. Ct. 456 (1951); Zurko III, 527 U.S. at 162.

Obviousness Analysis Must Include *Graham* Factual Findings

The examiner bears the initial burden of establishing a *prima facie* case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2D 1780, 1783 (Fed. Cir. 1992); Oetiker, 977 F.2d at 1445. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. Oetiker, 977 F.2d at 1445.

To reject claims in an application under Section 103, an examiner must show an un rebutted *prima facie* case of obviousness. In re Rouffet, 149 F.3d 1350, 1355, 47 U.S.P.Q.2D 1453, 1455 (Fed. Cir. 1998). The *prima facie* case is a procedural tool, and requires that the examiner initially produce evidence sufficient to support a ruling of obviousness; thereafter the burden shifts to the applicant to come forward with evidence or argument in rebuttal. In re Kumar, 418 F.3d 1361, 1366, 76 U.S.P.Q.2D 1048, 1050 (Fed. Cir. 2005). The patent applicant may attack the Examiner’s *prima facie* determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness. Fritch, 972 F.2d at 1265. When rebuttal evidence is provided, the *prima facie* case dissolves, and the decision is made on the entirety of the evidence. Kumar, 418 F.3d at 1366; Oetiker, 977 F.2d at 1445.

In Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), the Supreme Court established the test for consideration and determination of obviousness under 35 U.S.C. § 103. In Iron Grip Barbell Co. v. USA Sports Inc., the Federal Circuit explained how obviousness must be determined using the four-part Graham test:

we employ the four-part test set forth in Graham v. John Deere Co., 383 U.S. 1 (1966). This test requires us to examine

- (1) the scope and content of the prior art;
- (2) the level of ordinary skill in the art;
- (3) the differences between the claimed invention and the prior art; and
- (4) the objective evidence of nonobviousness. *Id.* at 17-18; see also 35 U.S.C. § 103 (2000).

392 F.3d 1317, 1320, 73 U.S.P.Q.2D (BNA) 1225 (Fed Cir. 2004); see also, Rouffet, 149 F.3d at 1355. U.S. Patent and Trademark Office policy is also to follow Graham. Accordingly, examiners should apply the test for patentability under 35 U.S.C. § 103 as set forth in Graham. M.P.E.P. § 2141 “35 U.S.C. 103; the Graham Factual Inquiries,” p. 2100-120, 8th ed., Rev. 2 (May 2004). Accordingly, during examination an examiner must conduct the four factual inquiries enunciated in Graham in determining obviousness of any claim.

The underlying factual determinations on which a conclusion of obviousness is allegedly based are reviewed to ascertain whether they are supported by substantial evidence. In re Kumar, 418 F.3d at 1365 (citing Gartside, 203 F.3d at 1316). Unsupported assessments of the prior art are unacceptable for purposes of review. “Rather, the Board must point to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise.” In re Zurko, 258 F.3d at 1385-86. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” Lee, 277 F.3d at 1344.

A determination of the level of ordinary skill in the art is an integral part of the Graham analysis. Ruiz v. A.B. Chance Co., 234 F.3d 654, 666, 57 U.S.P.Q.2D 1161, 1168 (Fed. Cir. 2000) (citing Custom Accessories Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962, 1 U.S.P.Q.2D 1196, 1201 (Fed. Cir. 1986)). Ascertaining a level of ordinary skill in the art is necessary. M.P.E.P. § 2141.03.

In making the assessment of differences between the prior art and the claimed subject matter, Section 103 specifically requires consideration of the claimed invention “as a whole.” Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 75, U.S.P.Q.2D 1051, 1054 (Fed. Cir. 2005); Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1275, 69 U.S.P.Q.2D 1686, 1690 (Fed. Cir. 2004). Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements”). The “as a

whole” instruction in title 35 prevents evaluation of the invention part by part and requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. Ruiz, 357 F.3d at 1275.

2A. Claims 1 – 4, 8 and 10 in light of Seelig in view of Muzaffar

Claims **1 – 4, 8 and 10** stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,997,400 to Seelig et al. (“Seelig” herein) in view of British Patent No. GB 2,372,218 to Muzaffar et al. (“Muzaffar” herein). Appellants respectfully traverse this rejection on the grounds set forth below.

Neither Seelig nor Muzaffar, alone or in combination, teach or suggest the following limitation of claim **1** (and thus of claims **2 – 4, 8 and 10**, by virtue of their respective dependency from claim **1**):

determining, based on a random number, a first outcome;
determining, at a second time, based on the first game situation and the first outcome, a second game situation, in which the second game situation includes a second amount of time available for completing the secondary game;
in which the difference between the first amount of time and the second amount of time is greater than the elapsed time between the first time and the second time

As the Office acknowledges, Seelig does not teach or describe reducing an amount of time available for completing the secondary game based on a first outcome that is determined based on a random number by more than the time elapsed between the first time and the second time. The Final Office Action argues that “[a]lthough Seelig does not specifically disclose that the first outcome is based on a random number generator, it is very well known in the art to utilize random number generators to generate outcomes in reel-type slot machines.” This conclusory statement ignores the context of the claim, however. For example, one consequence of determining a second game situation that includes a second amount of time based on the first

game situation and the first outcome is that the time remaining may be randomly increased or decreased based on the randomly determined first outcome. Seelig, on the other hand, only discloses reducing the amount of time based on the elapsed time. Although such a determination could arguably be considered to be based on the time taken to generate the first non-random outcome, the limitation of determining the time remaining based on a random outcome is not met merely by presuming, without evidence, that the outcome might be random. The limitation that the time remaining is also based on that random outcome must also be shown by substantial evidence. The Final Office Action has not done so here.

Appellants also respectfully disagree that Muzaffar cures the deficiency (as the Office suggests in its analysis of claim **10**, which recites a similar but narrower limitation). In Muzaffar, the only outcome that causes a reduction of time that is more than the time elapsed between a first time and a second time is a wrong answer by a player or a player passing on a set of images (pg. 3, second to last full paragraph). Such an outcome is not an outcome determined based on a random number. Rather, such an outcome is an outcome resultant of a player decision with respect to moving along within a game. The only such player decisions in Seelig are decisions to place a coin into the slot machine or pull the handle of the slot machine (Col. 5, lines 16 – 29). It would not make sense to combine the concept of Muzaffar (i.e., imposing a time penalty on a player for a decision of the player with respect to moving along within the game). If this feature of Muzaffar were combined with the game of Seelig, the result would be to penalize a player with a time deduction for inserting coins or pulling the handle of a slot machine. This result would render the Seelig slot machine unsatisfactory for its intended purpose (to encourage players to keep playing the slot machine and generate revenue for a gaming establishment, as made clear by the Background section of Seelig). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP 2143.01(V).

Since neither Seelig nor Muzaffar, alone or in combination, teach or suggest imposing a time penalty on a player as a result of an outcome that is determined based on a random number, Appellants respectfully submit that claim **1** (and all claims dependent therefrom, at least for this reason) are in condition for allowance.

2B. Claims 5 – 7 in light of Seelig in view of Muzffar and Walker

Claims 5 – 7 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Seelig in view of Muzaffar and further in view of U.S. Patent Application Publication No. 2001/0031654 to Walker et al. (“Walker” herein). Since Walker does not cure the deficiency of Seelig and Muzaffar, Appellants respectfully submit that claims 5 – 7 are allowable at least for the reasons set forth with respect to claim 1, in section 2A above.

2C. Claim 9 in light of Seelig in view of Muzaffar and Hedrick

Claim 9 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Seelig in view of Muzaffar and further in view of U.S. Patent No. 6,368,216 to Hedrick et al. (“Hedrick” herein). Since Hedrick does not cure the deficiency of Seelig and Muzaffar, Appellants respectfully submit that claim 9 is allowable at least for the reasons set forth with respect to claim 1, in section 2A above.

2D. Claim 20 in light of Baerlocher ‘200 in view of Hedrick

Claim 20 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Baerlocher ‘200 in view of Hedrick. Appellants respectfully traverse this rejection for the reasons set forth below.

Claim 20 is dependent from claim 17 and thus includes each of the limitations of claim 17. Since Hedrick does not cure the deficiency of Baerlocher ‘200, discussed above in section 1A above, Appellants respectfully submit that claim 20 is patentable at least for the same reason as claim 17.

2E. Claim 22 in light of Webb in view of Seelig

Claim 22 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Webb in view of Seelig. Appellants respectfully traverse this rejection for the reasons set forth below.

Claim 22 is dependent from claim 11 and thus includes each of the limitations of claim 11. Since Seelig does not cure the deficiency of Webb, discussed above in section 1B above, Appellants respectfully submit that claim 22 is patentable at least for the same reason as claim 11.

2F. Claim 23 – 24 in light of Baerlocher ‘200 in view of Seelig

Claims **23 and 24** stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Baerlocher ‘200 in view of Seelig. Appellants respectfully traverse this rejection for the reasons set forth below.

Claims **23 and 24** is dependent from claims **13 and 17** respectively and thus include each of the limitations of respective claims **13 and 17**. Since Seelig does not cure the deficiency of Baerlocher ‘200, discussed above in section 1A above, Appellants respectfully submit that claims **23 and 24** is patentable at least for the same reason as respective claims **13 and 17**.

CONCLUSION

Accordingly, the Examiner's rejection of the pending claims is improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Jerome DeLuca using the information provided below.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

Respectfully submitted,

March 28, 2008

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APPENDIX A—CLAIMS INVOLVED IN THE APPEAL

All of the pending claims (Claims 1-24) are being appealed.

Claims 1, 11, 13 and 17 are independent.

1. A method comprising:
 - initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls;
 - determining at a first time a first situation of the secondary game, in which the first situation includes a first amount of time available for completing the secondary game;
 - determining, based on a random number generator, a first outcome; and
 - determining, at a second time, based on the first game situation and the first outcome, a second game situation, in which the second game situation includes a second amount of time available for completing the secondary game;

in which the difference between the first amount of time and the second amount of time is greater than the elapsed time between the first time and the second time.
2. The method of 1 further including determining a reduction of time associated with the first outcome.
3. The method of 2 in which determining a second game situation includes determining, at a second time, based on the first game situation and the reduction of time, a second game situation, in which the second game situation includes a second amount of time available for completing the secondary game.
4. The method of 2 in which the difference between the first amount of time and the second amount of time is equal to the sum of the reduction of time and the elapsed time between the first time and the second time.

5. The method of 1 in which determining a first situation includes determining, at a first time, a first situation of the secondary game, in which the first situation includes a first amount of time available for completing a first number of handle pulls in the secondary game.

6. The method of 5 in which determining a second situation includes determining, at a second time, based on the first game situation and the first outcome, a second game situation, in which the second game situation includes a second amount of time available for completing a second number of handle pulls in the secondary game.

7. The method of 6, in which the second number of handle pulls is one less than the first number of handle pulls.

8. The method of 1 in which determining a first situation includes determining at a first time a first situation of the secondary game, in which the first situation includes a first amount of time available for a game character to reach a destination in the secondary game.

9. The method of 1 in which determining a first situation includes determining at a first time a first situation of the secondary game, in which the first situation includes a first amount of time available to obtain a target number of game indicia.

10. The method of 1 in which determining the first outcome includes:
receiving an initiation signal from a player;
generating a random number;
determining an outcome associated with the random number, in which the outcome comprises a set of symbols;
spinning a set of reels of the gaming device; and
stopping the reels such that the set of symbols are visible to the player.

11. A method comprising:
- initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls;
 - determining a first situation of the secondary game, in which the first situation includes a first number of handle pulls available for completing the secondary game;
 - determining a first outcome; and
 - determining based on the first game situation and the first outcome, a second game situation, in which the second game situation includes a second number of handle pulls available for completing the secondary game.
12. The method of claim 11 in which the second number of handle pulls is (i) less than one less than the first number of handle pulls and (ii) greater than one.

13. A method comprising:
initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls
determining a first situation of the secondary game,
in which the first situation includes a first plurality of locations that may be occupied by a game character,
in which the first situation includes a first set of connections among the first plurality of locations, and
in which at least one of the first plurality of locations confers an advantage to a player if occupied by the game character;
determining a first outcome; and
determining a second situation of the secondary game,
in which the second situation includes a second plurality of locations that may be occupied by the game character,
in which the second situation includes a second set of connections among the second plurality of locations, and
in which at least one of the second plurality of locations confers an advantage to the player if occupied by the game character,
wherein there is at least one difference between at least one of
the first plurality of locations of the first situation as compared to the second plurality of locations of the second situation and
the first set of connections of the first situation as compared to the second set of connections of the second situation.

14. The method of 13 in which the second situation includes a second set of connections among the second plurality of locations, the second set of connections differing from the first set of connections.

15. The method of 13 in which the second situation includes a second plurality of locations that may be occupied by the game character, the second plurality of locations differing from the first plurality of locations.

16. The method of 13 in which the second situation includes a second plurality of locations that may be occupied by the game character, the first plurality of locations including one location not included in the second plurality of locations.

17. A method comprising:
initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls;
determining a first situation of the secondary game, in which the first situation includes an objective within the secondary game and a first prize amount associated with the objective;
determining a first outcome; and
determining, based on the first situation and the first outcome, a second situation, in which the second situation includes the objective and a second prize amount associated with the objective.

18. The method of 17 in which determining a second situation includes determining, based on the first situation and the first outcome, a second situation, in which the second situation includes the objective and a second prize amount associated with the objective, and in which the second prize amount is different from the first prize amount.

19. The method of 17 in which determining a first situation includes determining a first situation of the secondary game,
in which the first situation includes an objective for a game character to reach a particular square on a game board, and
in which the first situation includes a first prize amount associated with the objective.

20. The method of 17 in which determining a first situation includes determining a first situation of the secondary game,
in which the first situation includes an objective for a player to obtain a certain number of symbols on reels of the gaming device over the course of multiple spins, and
in which the first situation includes a first prize amount associated with the objective.

21. The method of claim 1, further comprising:
receiving a prepayment for the two or more handle pulls prior to an initiation of the secondary game, wherein the prepayment is distinct from an addition of credits to a balance of credits available for wagering on a primary game.

22. The method of claim 11, further comprising:
receiving a prepayment for the two or more handle pulls prior to the initiation of the secondary game, wherein the prepayment is distinct from an addition of credits to a balance of credits available for wagering on a primary game.

23. The method of claim 13, further comprising:
receiving a prepayment for the two or more handle pulls prior to the initiation of the secondary game, wherein the prepayment is distinct from an addition of credits to a balance of credits available for wagering on a primary game.

24. The method of claim 17, further comprising:
receiving a prepayment for the two or more handle pulls prior to the initiation of the secondary game, wherein the prepayment is distinct from an addition of credits to a balance of credits available for wagering on a primary game.

APPENDIX B—EVIDENCE

<NONE>

APPENDIX C—RELATED PROCEEDINGS

<NONE>